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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,651	10/13/2000	Graciela Chichilnisky	23366-703	6637

7590 12/27/2004

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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/687,651	<b>Applicant(s)</b> CHICHILNISKY, GRACIELA	
	<b>Examiner</b> Lalita M Hamilton	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 10-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of claims 1-9 in the reply filed on November 22, 2004 is acknowledged.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins (5,497,317).

Hawkins discloses a method for improving the reliability of security trade settlements comprising providing a host system or systems with a distributed relational database accessible and updateable by more than one party to a cross border transaction, caching a client's standing settlement instructions in a client profile in the distributed relational database, monitoring messages of a selected trade settlement client, and assigning a unique transaction identifier of a trade settlement for messages that include an execution file or a settlement of a trade (col.2, lines 15-50; col.3, lines 20-45; col.6, lines 15-25; and col.5, lines 12-55); receiving at the host system (or systems) an execution file that includes trade settlement parameters and matching messages of the selected trade settlement process using the information in the execution file and the standing instruction parameters and adding said messages to the

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logical transaction workflow (col.7, line 10 to col.8, line 2); marking matched messages with the transaction identifier and storing the marked traffic in the distributed relational database as part of a logical transaction for a trade settlement (col.7, line 10 to col.8, line 2); the client standing instructions include instructions for executing a trade including, but not limited to clearing methods, name of correspondent banks, sub agent or sub custodian, name of sub agent, client tax identification number, and account type (col.3, lines 30-40 and col.7, lines 1-20); the execution file includes information about a specific trade, including, but not limited to, payment currency, client name, trade date, settlement date, security name, security type, and security code (col.3, lines 30-40 and col.7, lines 1-20); and providing a host system with a distributed relational database accessible and updateable by more than one party to a cross border transaction, receiving a copy of an execution file from a broker dealer to a global custodian, assigning a unique logical transaction number to a settlement detailed in the execution file, examining a profile database of the global custodian for the standing instructions from asset managers originating the trade, monitoring traffic at the global custodian, matching messages to the logical transaction process based upon content, their implicit relationship to the settlement detailed in the execution file, and the global custodian's standing instructions, updating the settlement in the workflow database, indicating the state of the settlement, tiring any conditional workflow related triggers related to time/content, based upon the global custodian's profile database entry, and allowing the global custodian to interrogate the workflow database to determine the current state of

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the settlement transaction (col.2, lines 15-50; col.3, lines 20-45; col.5, lines 12-55; col.6, lines 15-25; and col.7, line 1 to col.8, line 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Chen (6,195,694).

Hawkins discloses the invention substantially as claimed; however, Hawkins does not disclose the monitoring is done by an electronic file transfer; electronic file transfer is from a client's computer network to the host network system; or the monitoring is done with a standard web browser. Chen teaches a server for use in online trading (col.26, lines 10-20) comprising the monitoring being done by an electronic file transfer (col.15, lines 25-40); electronic file transfer is from a client's computer network to the host network system (col.15, lines 25-40); and the monitoring

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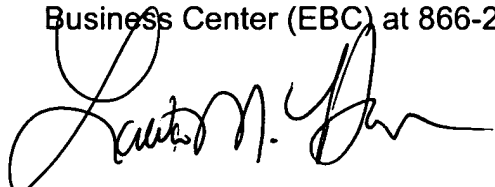
is done with a standard web browser (col.11, lines 50-65). It would have been obvious to one having ordinary skill in the art to incorporate monitoring is done by an electronic file transfer; electronic file transfer is from a client's computer network to the host network system; and the monitoring is done with a standard web browser, as taught by Chen into the invention disclosed by Hawkins, to provide a means of using the trade settlement system using the internet.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH